

REMARKS

Reconsideration and allowance of the present application based on the foregoing amendments and the following remarks are respectfully requested.

Claims 1-2, 4, 6-9, 11, and 13-48 are currently pending in the present application. Claims 1, 4, 11 and 22 have been amended and claims 3, 10 and 49-51 have been canceled.

Independent claim 1 has been rejected as being obvious over Homeyer and Erhard. To obviate this rejection, claim 1 has been amended to more clearly define the scope of the claimed invention, and differentiate from these references.

The claimed invention is particularly advantageous for typical day skiers, as well as backcountry skiers. With the construction of the claimed device, an elongated ski can be carried on the wearer's back in a well-balanced manner and in a position to avoid interference with the wearer's walking gait. This improved positioning makes it easier for the wearer to walk, and the enhanced balance of the load allows the wearer to walk longer distances without discomfort. With backcountry skiers, this is particularly important, as they may be required to traverse long stretches of terrain, including relative precarious ridges, etc., in order to access backcountry skiing.

To achieve these advantages, the invention of claim 1 incorporates two key features:

1. “[T]he one or more support members are elongated and extend downwardly from the harness to suspend the receptacle at a position below the wearer's buttocks when the wearable device is worn in the operative position.” This is advantageous because it allows the elongated articles (e.g., skis) to be carried on the wearer's back at a well-located center of gravity, as opposed to having them riding high on the wearer's back in an uncomfortable manner.

2. “[T]he one or more retainers are positioned at an angle on the main body so as to retain the elongated article at an angle relative to a vertical axis of the wearer when the wearable device is worn in the operative position.” And the one or more support members are “flexible for moving the receptacle to accommodate the angle of the elongated structure and receive the lower opposing end thereof.” These features in combination with downward extension of the support members are advantageous because they allow the elongated article to be carried at an angle to the wearer's body. Specifically, with just feature 1, the elongated article can be carried with its lower end hanging in a position that is behind the wearer's legs – which may interfere with his/her walking gait. But when features 1 and 2 are combined as

claimed, the lower end of the elongated article will be at an angle, thus enabling it to be clear of the wearer's walking gait (see Figs. 3-7 of the application).

Homeyer clearly lacks both these features. Indeed, the Examiner acknowledges that feature 1 is lacking from Homeyer. (Office Action at 3). Feature 2 was added by this amendment, and the Applicants respectfully submit that this also is lacking from Homeyer.

Specifically, the only structure in Homeyer that could arguably correspond to the "one or more retainers" is shown at 11. This structure, however, is not shown as being at an angle to the main body of the device, as required by claim 1. And thus, it cannot function to retain an elongated article at an angle as required by claim 1. Claim 1 specifically requires that "the one or more retainers" be "positioned at an angle on the main body so as to retain the elongated article at an angle relative to a vertical axis of the wearer when the wearable device is worn in the operative position." This is not shown in Homeyer.¹

Moreover, it is the combination of these elements that are important, not just the elements by themselves. As mentioned above, with this specific combination of features 1 and 2, an elongated article can be carried and retained at an angle by the "one or more retainers," and the "one or more support members" allow the receptacle to move to accommodate that angle.

The Examiner relies on Erhard to teach the presence of the "one or more support members" that are "elongated and extend downwardly from the harness to suspend the receptacle at a position below the wearer's buttocks when the wearable device is worn in the operative position" (i.e., feature 1). However, Erhard simply shows a shoulder loop style carrier with an elongated strap. It provides no teachings about proper positioning on the wearer's back, and thus would not suggest the alleged modification to Homeyer. Indeed, Erhard is devoid of any mention of proper positioning and balance, and the fact that it uses a shoulder loop emphasizes this. A shoulder loop by definition loads all weight on one shoulder, and therefore is uncomfortable when used for a long period of time. Moreover, most shoulder loop carriers require the user to either keep one hand on the loop to keep it on the shoulder, or repeatedly re-adjust the loop.² When used with skis, this is a risky

¹ Admittedly, an irregular shaped object, such as the bow in Figure 8 of Homeyer, may be at a slight angle simply because of its natural curvature. However, the "retainer" itself is not an angle, and thus it does not function to position that bow at an angle. This is an important distinction to note, as the angle of the claimed "one or more retainers" ensures that the elongated article will be at an angle.

² To put this in context, the Examiner may consider the situation where one carries backpack by one strap on the shoulder. Typically, the wearer keeps one hand on the strap, or repeatedly readjusts the strap while walking.

proposition, as the user is likely on snowy or icy terrain – and coupled with an unbalanced ski load on the shoulder falling is a higher risk.³

As such, Erhard provides no suggestion that would lead one of ordinary skill in the art to modify the Homeyer device. Furthermore, to do so would be contrary to the very teachings of Homeyer, which is impermissible.

In establishing the first prong of the *prima facie* obviousness case, namely the provision of a motivation or suggestion, the Examiner must consider each prior art reference as a whole, and cannot pick only those portions that support his position. As stated by the CCPA in *In re Wesslau*, “it is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” 353 F.2d 238, 241 (CCPA 1965). Thus, the Examiner must consider portions of the prior art that “teach away” from the Applicants’ invention. See, e.g., Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, 796 F.2d 443, 448 (Fed. Cir. 1986) (reversing obviousness finding and stating district court failed to consider prior art reference in its entirety by ignoring portions that argued against obviousness).

An important feature of Homeyer is to enable the device to be worn while riding an ATV or on horseback. As such, Homeyer identifies the importance of positioning the carried equipment “high enough on the wearer’s back to allow him to be seated on an ATV or on horseback without having the equipment touch the vehicle seat or frame or the horse’s back or saddle, thereby reducing or eliminating the effect of vehicle vibrations and jolts on the equipment.” Homeyer at column 2, lines 18-23. See also, Homeyer at column 1, lines 26-35, and column 2, lines 37-41 (discussing issues with riding ATV or horseback, and identifying convenient carriage of an item as being an “object of the invention.”). This is the exact opposite of the Applicants’ invention, which seeks to lower the positioning of the elongated object with the use of the “one or more support members” that are “elongated and extend downwardly from the harness so as to suspend the receptacle at a position below the wearer’s buttocks when the device is worn in the operative position.”

As such, the alleged modification of Homeyer (even if Erhard did suggest such a modification) would defeat the teachings and advantages of Homeyer. Based on this understanding of Homeyer as a whole, it is clear that the “support member” of Erhard cannot be combined into Homeyer because that would change the basic and fundamental principles

³ A translation of Erhard is enclosed for the Examiner’s review.

underlying the teachings of Homeyer. This is impermissible in formulating the prima facie case of obviousness. See MPEP § 2143.01. See also, *In re Ratti*, 270 F.2d 810 (CCPA 1959) (reversing rejection because combination of references would require substantial reconstruction and redesign of primary reference, as well as change the basic principle under which the primary reference was designed to operate). This is the type of picking and choosing of parts of the references, without a “full appreciation of what such reference fairly suggests” that Wesslau counsels against.

Indeed, an important issue to take into account is the fact that many skiers often ride ski lifts, or in the case of backcountry skiing snowmobiles, to the place where they will begin skiing. To the extent that the Examiner alleges that one of ordinary skill in the art would be motivated by Erhard to use the claimed downwardly depending support member(s) for locating the receptacle below the wearer’s buttocks, one of ordinary skill in the art could just as easily conclude from reading Homeyer that this would not be a good idea, because then the device could not be worn while riding a ski lift or snowmobile. This is because Homeyer specifically keeps the receptacle at a higher location on the wearer’s body and avoids the use of such downwardly depending support member(s) so the user can ride a horse or vehicle. Thus, it is improper to conclude that the combination of Homeyer and Erhard necessarily teach the claimed invention, when in effect reading them together with an understanding of how people often transport skis just lends itself to the opposite conclusion. See *In re Mills*, 916 F.2d 680, 682 (Fed.Cir. 1990)(stating that although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.”).

Accordingly, for at least the foregoing reasons, the Applicants submit that claim 1 is patentable over the applied references, and request the Examiner to withdraw the outstanding rejection.⁴

Claims 2-4, 6-11, and 13-48 depend from claim 1 and are submitted to distinguish from the art of record for at least the reasons advanced above with respect to claim 1, and for the additional reason that they each recite additional patentable features.

For example, claim 6 recites that “the one or more elongated support members includes a plurality of flexible straps connected between the main body and the receptacle,” and claim 7 recites that “each of the flexible straps have length adjusters to enable adjustment of a distance at which the receptacle is suspended below the main body when the wearable



device is worn in the operative position." The art does not support these limitations, and certainly not in the specific combination claimed. These features enhance the ability to properly center and angle the elongated article, which is synergistic in the claimed combination. The same argument applies to claim 9, which recites the ability to vertically adjust the distance at which the receptacle is suspended below the harness.

Claims 49-51 have been canceled to narrow the issues in this application, and this cancellation is without prejudice or disclaimer to pursuit of these claims in a continuation application.

All objections and rejections having been addressed, it is respectfully submitted that the present application is in a condition for allowance and a Notice to that effect is earnestly requested.

If the Examiner has any questions concerning this response, or the application in general, he/she is encouraged to contact the undersigned at the below-listed phone number to help facilitate prosecution of this application.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,

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⁴ The Applicants still maintain other positions advanced in their previous amendment. For example, the Applicants still maintain that the straps 6 and 7 in Homeyer cannot be regarded as the support members.